REMARKS

Claims 1-41 and 48-50 are pending, with claims 1, 8, 17, 23, 26, 48, and 49 being independent. Claims 1-16 and 18-25 are original, claims 8 and 17 are being amended for the first time, claims 26-41, 49, and 50 are new, and claims 42-47, 51, and 52 have been cancelled.

Reissue Declaration

The office action rejected claims 1-41 and 48-50 as being based on a defective reissue declaration because the reissue declaration filed June 29, 2001 includes an error for which correction is not being sought in any of the pending claims. Applicant submits herewith a new reissue declaration including an error for which correction is sought.

Proper Broadening Reissue Claims

Claims 26-38, 41, and 48-50 were rejected for improper recapture of subject matter surrendered in the application for patent upon which the reissue application is based. Particularly, the office action stated that "the subject matter in [claims] 6, 14, 20, 29 [of the application for patent upon which the reissue application is based] … form the basis for recapture scrutiny." The office action further stated that claims 6, 14, and 20 "represent the feature [of showing] ads for a training period and determin[ing] whether the proportion of those in the community have chosen the ad is a high proportion or a low proportion" and that claim 29 "represents the feature that the user can reject the displayed ad and it will be replaced with a second ad." Withdrawal of the rejection of claims 26-38, 41, and 48-50 is requested for at least the following reasons.

As to claims 26-38, and 41, the recapture rejection should be withdrawn at least because claim 26 now recites "displaying a new advertisement for a training period" and "determining whether a high or low proportion of members of the user's community have viewed further information about the advertisement." Thus, to the extent that claim 26 may be considered to be broader than the claims of the patent for which reissue is sought, claim 26 is <u>not</u> broader in the area of any subject matter surrendered in the application for patent upon which the reissue application is based.

As to claim 48, the recapture rejection should be withdrawn at least because claim 48 recites "receiving from said user an indication that the user rejects said first advertisement; and replacing said first advertisement with a second advertisement in response to said rejection indication received from said user." Thus, to the extent that claim 48 may be considered to be broader than the claims of the patent for which reissue is sought, claim 48 is not broader in the area of any subject matter surrendered in the application for patent upon which the reissue application is based.

As to claims 49 and 50, the recapture rejection should be withdrawn at least because claim 49 recites features that make it narrower with respect to subject matter other than the subject matter that was surrendered during prosecution of the application for patent upon which the reissue application is based. For example, claim 49 recites "storing at a user computer information based upon the activity of at least one user in an interactive medium; receiving at said user computer advertisement criteria; and deciding at said user computer if an advertisement is to be shown at said user computer based upon said information and said advertisement criteria." These features, or similar features, are not found in the claims prosecuted in the application for patent upon which the reissue application is based. Thus, although claims 49 and 50 may be broader with respect to subject matter surrendered during prosecution of the application for patent upon which the reissue application is based, the claims have not been impermissibly enlarged.

Statutory Subject Matter

Claims 8-16, 26-41, and 48-50 were rejected as being directed to non-statutory subject matter. Each of claims 8-16, 26-41, and 48-50 is believed to now recite statutory subject matter. Therefore, reconsideration and withdrawal of the rejection of these claims is requested.

Non-Obviousness

Claims 26-38, 41, and 48-50 were rejected as being unpatentable over "An Open Architecture For Collaborative Filtering" ("Miller") in view of United States Patent No. 5,754,938 ("Herz").

As to claim 26, Miller and Herz, alone or in combination, fail to disclose or suggest "displaying a new advertisement for a training period" and "determining whether a high or low proportion of members of the user's community have viewed further information about the advertisement," as now recited in claim 26. Therefore, reconsideration and withdrawal of the rejection of claims 26-38 and 41 are requested.

As to claim 48, Miller and Herz, alone or in combination, fail to disclose or suggest "sending a first advertisement to a user computer; receiving from said user computer an indication that the user rejects said first advertisement; and replacing said first advertisement with a second advertisement in response to said rejection indication received from said user," as recited in claim 48. In particular, applicant notes that although claim 48 is nominally rejected on page 6 of the office action, no explanation is provided regarding how or where the cited references disclose these features of claim 48, or how or why it would have been obvious to combine the references. For at least these reasons, reconsideration and withdrawal of the rejection of claim 48 are requested.

As to claim 49, Miller and Herz, alone or in combination, fail to disclose or suggest "storing on a user computer information based upon the activity of at least one user in an interactive medium; receiving by said user computer advertisement criteria; and deciding by said user computer if an advertisement is to be shown at said user computer based upon said information and said advertisement criteria," as recited in claim 49.

For example, the office action cited col. 34, lines 36-43 of Herz as disclosing "a computer program product wherein the product further comprises computer readable program code means for recording the information in a tracking database stored locally at the guest's remote location." However, the cited portion of Herz discloses only that "[e]ach proxy server maintains an encrypted target profile interest summary associated with each allocated pseudonym in its pseudonym database D. The actual user-specific information and the associated pseudonyms need not be stored locally on the proxy server, but may alternatively be stored in a distributed fashion and be remotely addressable from the proxy server via point-to-point connections." Thus, the cited portion of Herz does not support the assertion of the office for which it is cited; in

other words, the cited portion of Herz does not disclose "computer readable program code means for recording the information in a tracking database stored locally at the guest's remote location."

As to the features of "receiving by said user computer advertisement criteria" and "deciding by said user computer if an advertisement is to be shown at said user computer based upon said information and said advertisement criteria," the office action fails to provide any indication of the portion of Herz or of Miller that is believed to disclose these features.

For at least these reasons, reconsideration and withdrawal of the obviousness rejection of claims 49 and 50 are requested.

All pending claims are in condition for allowance, and prompt issuance of a notice of allowance indicating the same is requested. Should there be any questions or concerns with the application, please contact applicant's undersigned representative to schedule an interview.

Payment in the amount of $1,110 for the requisite fee for a three-month extension of time is made concurrently herewith on the Electronic Filing System (EFS) by way of Deposit Account authorization. Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

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